



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Erion *et al.*

Serial No.: 09/978,454

Filed: October 15, 2001

Title: NOVEL PRODRUGS FOR
PHOSPHORUS-CONTAINING
COMPOUNDS

Group Art Unit: 1616

Examiner: Dameron Jones

Commissioner for Patents
Washington, D.C. 20231

AMENDMENT AND RESPONSE

&

PETITION FOR EXTENSION OF TIME

Dear Sir:

This communication is responsive to the Office Action mailed October 24, 2002.

Applicants hereby petition for a two-month extension of time in which to respond to the Office Action mailed on October 24, 2002. With the granting of the foregoing Petition, the time for responding to this Office Action is extended to include January 24, 2003. The Commissioner is hereby authorized

CERTIFICATE OF TRANSMISSION
(37 C.F.R. §1.8)

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to charge trust account No. 50-1273 for the two –month extension fee due herein, and any other fees that may become due or credit become payable during the pendency of this application.

AMENDMENTS

Please amend the claims to read as follows:

169. (Once Amended) The pharmaceutical composition of claim 168, wherein MH is 9-(2-phosphonylmethoxyethyl)adenine (PMEA) or analogues thereof.

170. (Once Amended) The pharmaceutical composition of claim 168, wherein MH is 9-(2-phosphonylmethoxyethyl)adenine (PMEA).

171. (Twice Amended) The pharmaceutical composition of claim 168, wherein MH is selected from penciclovir, 3TC, ACV, PMPA, araC, ribavirin, fludarabine, and 5-fluoro-2'-deoxyuridine.

172. (Once Amended) The pharmaceutical composition of claim 168, wherein MH is radiolabelled 2'-deoxy-5-Iodouridine.

173. (Once Amended) The pharmaceutical composition of claim 172 wherein MH is 2'-deoxy-5-¹³¹I-iodouridine.

174. (Once Amended) The pharmaceutical composition of claim 168, wherein V is selected from the group consisting of aryl, substituted aryl, heteroaryl, and substituted heteroaryl.

175. (Once Amended) The pharmaceutical composition of claim 168, wherein the prodrug is in the *cis* configuration.

176. (Once Amended) The pharmaceutical composition of claim 174, wherein the prodrug is in the *cis* configuration.

177. (Once Amended) The pharmaceutical composition of Claim 171, wherein MH is araC and V is a heteroaryl group.

178. (Once Amended) The pharmaceutical composition of claim 177, wherein V is 4-pyridyl.

179. (Once Amended) The pharmaceutical composition of claim 172 wherein MH is 2'-deoxy-5-¹²⁵I-iodouridine.

REMARKS

Claims 168-185 are pending in this Application. Claims 168-185 are subject to an Election of Species Requirement.

Claims 169-179 were amended to comply with the Examiner's renumbering of the claims. As such, the amendments do not constitute new matter. In accordance with 37 C.F.R. § 1.121, a marked up copy of the presently amended claims is appended hereto. Additions are noted by underlining. Deletions are noted by bracketing. Furthermore, to ensure that Applicants' pending claims match those of the Patent Office, a clean copy of the entire set of pending claims is also appended hereto.

Election of Species Requirement

The Examiner contends that "claims 168-185 are generic to a plurality of patentably distinct species comprising phosphorous-containing compounds." (Office Action p. 2) The Examiner requires that the Applicants elect a single disclosed species.

The Applicants respectfully contend that the claimed compounds of Formula I present sufficiently few species and that they can be readily evaluated together. Indeed a search of any of the species of the allegedly generic claims would, by necessity, include a search of art relevant to the other

species of such claims. The Applicants submit that such a search would not be an undue burden on the Examiner.

In view of the above, Applicants respectfully request removal of the election of species requirement. The Applicants further understand that claims drawn to nonelected species will no longer be withdrawn if any generic claim is found to be allowable.

In order to be fully responsive, the Applicants hereby elect the following species, with traverse. The elected species is a compound of Formula I, wherein MH is araC; Z, W, and W' are hydrogen; and V is 4-pyridyl.

The Applicants believe that claims 168, 171, 174, 175-178, 181, and 183 are drawn to the elected species.

Respectfully Submitted,

Date: 1/21/03

By: Diana L. Bush

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Reg. No. 51,109

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MARKED UP COPY OF THE AMENDED CLAIMS

169. (Once Amended) The pharmaceutical composition of claim [2]168, wherein MH is 9-(2-phosphonylmethoxyethyl)adenine (PMEA) or analogues thereof.

170. (Once Amended) The pharmaceutical composition of claim [2]168, wherein MH is 9-(2-phosphonylmethoxyethyl)adenine (PMEA).

171. (Twice Amended) The pharmaceutical composition of claim [2]168, wherein MH is selected from penciclovir, 3TC, ACV, PMPA, araC, ribavirin, fludarabine, and 5-fluoro-2'-deoxyuridine.

172. (Once Amended) The pharmaceutical composition of claim [2]168, wherein MH is radiolabelled 2'-deoxy-5-Iodouridine.

173. (Once Amended) The pharmaceutical composition of claim [6]172 wherein MH is 2'-deoxy-5-¹³¹I-iodouridine.

174. (Once Amended) The pharmaceutical composition of claim [2]168, wherein V is selected from the group consisting of aryl, substituted aryl, heteroaryl, and substituted heteroaryl.

175. (Once Amended) The pharmaceutical composition of claim [2]168, wherein the prodrug is in the *cis* configuration.

176. (Once Amended) The pharmaceutical composition of claim [8]174, wherein the prodrug is in the *cis* configuration.

177. (Once Amended) The pharmaceutical composition of Claim [5]171, wherein MH is araC and V is a heteroaryl group.

178. (Once Amended) The pharmaceutical composition of claim [11]177, wherein V is 4-pyridyl.

179. (Once Amended) The pharmaceutical composition of claim [6]172 wherein MH is
2'-deoxy-5-¹²⁵I-iodouridine.

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MESSAGE Re: U. S. Patent Application Ser. No. 09/078,454 Filed Date: 10/15/2001 Our Ref: 030727.0027.CON1 Please find attached Amendment & Response and Petition for Extension for Time relating to Office Action mailed 10/24/2002 in the above-referenced application.					
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